

Application No. 09/682,170

RD-29400-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of
BONITATEBUS, Jr.

Serial No. 09/682,170

Group Art Unit: 1754

Filed: July 31, 2001

Examiner: Jonas N. Strickland

For METHOD FOR REACTIVATING A DEACTIVATED CATALYST
COMPOSITION

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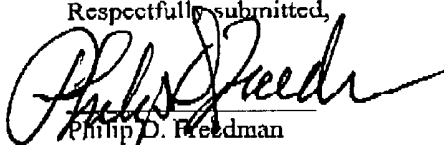
To: Examiner: Jonas N. Strickland
Group Art Unit: 1754
TC 1700

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Second Request for Reconsideration after Final Rejection under 37 C.F.R. §1.116 (4 pages)

Respectfully submitted,



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25 APR 2004

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RESPONSE UNDER 37 CFR §1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 1754

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For METHOD FOR REACTIVATING A DEACTIVATED CATALYST
COMPOSITION

SECOND REQUEST FOR RECONSIDERATION AFTER FINAL
REJECTION UNDER 37 C.F.R. §1.116

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Sir:

Claims 1 to 84 are pending. The February 3, 2004 Final Rejection rejected claims 1 to 84 under 35 U.S.C. 112, first paragraph. The April 8 Advisory Action in this case continues the rejection of claims 1 to 84 under 35 U.S.C. §112, first paragraph. Reconsideration of the 35 U.S.C. 112, first paragraph rejection is requested for the following reasons.

The Advisory Action first states:

Applicant argues wherein the specification paragraphs [0003] and [0033] and particularly the detailed step by step procedure in [0035] enable one skilled in the reactivation carbonylation catalyst art to make use of a catalyst directly without intervening reducing step or oxidizing step, as a carbonylation catalyst". It should be noted that the 35 USC 112, 1st paragraph rejection is not based on enablement, but rather the written description of the specification.

This statement is incorrect. Applicants' argument is that

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The specification, paragraph [0003] describes providing a reactivated catalyst "without the need to individually isolate, purify, and reconstitute the various components of the catalyst composition" as an objective of the invention. Paragraph [0033] describes "an evaporation step... performed on the third liquid reaction mixture in order to reduce the volume, by removing a predetermined amount of water, to produce a concentrated third liquid reaction mixture which can... *be returned to a subsequent carbonylation reaction to effectively catalyze the carbonylation of an aromatic hydroxy compound...*" (emphasis added). In another paragraph [0033] embodiment an "evaporation step" yields a sixth liquid reaction mixture, which comprises the active catalyst composition and is *ready to be returned to a subsequent carbonylation reaction to effectively catalyze the carbonylation or [sic, of] an aromatic hydroxy compound*" (emphasis added). Example 1, paragraph [0035] describes reactivating a deactivated carbonylation catalyst composition" and using the reactivated catalyst "directly" "without intervening reducing step or oxidizing step" as claimed in the claims.

Specification paragraphs [0003], [0033] and particularly the detailed step by step procedure described in paragraph [0035] enable one skilled in the reactivation carbonylation catalyst art to make and use the catalyst "without intervening reducing step or oxidizing step." The rejection of claims 1 to 84 under 35 U.S.C. 112, first paragraph should be withdrawn.

Applicants' March 13, 2004 Request for Reconsideration, pages 1 to 2.

This argument addresses the 35 USC §112, 1st paragraph "written description" requirement, not a utility requirement.

Further the advisory action states:

The specification does not specifically recite wherein the catalyst is "used directly without intervening reducing step or oxidizing step. as a carbonylation catalyst", as required in instant claims 1, 31, and 82-84. Therefore, the 35 USC 112, 1st paragraph.

But the PTO is incorrect in stating that 35 USC 112, 1st paragraph requires specific recitation of "used directly without intervening reducing step or oxidizing step, as a carbonylation catalyst." 35 U.S.C. §112, first paragraph states that "the specification shall contain a written description of the invention, and of the manner and process of making and using it ... to enable *any person skilled in the art...* to make and use the

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same..." (emphasis added). *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976) states:

... [an] application need not describe claim limitations exactly, but only so clearly that a person of ordinary skill in the art will recognize from the disclosure that applicants invented processes included these limitations.

The present specification paragraph [0003] describes a need to use a carbonylation catalyst in a subsequent carbonylation reaction without "isolat[ing], purify[ing] and reconstitut[ing]" the catalyst after use in a previous carbonylation reaction. It is known to one skilled in the art that an "intervening reducing step" and "oxidizing step" are the "isolat[ing], purify[ing] and reconstitut[ing]" steps to reconstitute a carbonylation catalyst. See Ofori et al. 5,981,788. The [0003] paragraph disclosure, the remaining specification disclosure of a method that does not include an "intervening reducing step" or "oxidizing step," and the specific example paragraphs [0033] and [0035] describe methods "for reactivating a deactivated carbonylation catalyst composition" "without "intervening reducing step" or "oxidizing step." From this specification disclosure, a person of ordinary skill in the art recognizes a step of using a reactivated catalyst "directly without intervening reducing step or oxidizing step" in a subsequent carbonylation reaction. The rejection of claims 1 to 84 under 35 U.S.C. 112, first paragraph should be withdrawn.

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In view of the foregoing remarks, it is respectfully submitted that claims 1 to 84 are allowable. Reconsideration and allowance are requested.

Should the Examiner believe that any further action is necessary in order to place this application in condition for allowance, he is requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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April 25, 2004